

REMARKS

Claims 1-10, 14-23, and 40-45 are now pending in this application for which applicants seek reconsideration.

Amendment

Fig. 1 has been amended to include reference number 100. Claims 11-13, 24-27, and 32 have been canceled. Remaining independent claims 1, 6, 14, and 19 have been amended to more clearly set forth the present invention, as well as to remove the informalities identified by the examiner and to improve their form and clarity. Specifically, these claims now define reading identification information assigned to the insert sheets and generating an output indicating the read identification information. No new matter has been introduced.

Restriction

Although the Office Action Summary indicated that claims 11-13 and 24-26 have been withdrawn, the Detailed Action (page 8) rejected these claims on the merits. Although the restriction is moot due to these claims being canceled, nonetheless, it makes a difference whether these claims remain under restriction for continuation/divisional filing purposes. Applicants therefore seek clarification as to the restriction status of these claims.

Art Rejection

Claims 1-27 and 32 were rejected under 35 U.S.C. § 103(a) as unpatentable over Inoue (USP 5,159,546) in view of York (USP 4,602,776). Applicants traverse this rejection at least to the extent that these references would not have disclosed or taught reading identification information as set forth in the claims as presently amended.

As presently clarified, each of the bundles of insert sheets has a plurality of pages to be inserted. Reading means reads the identification information assigned to the insert sheets. According to the pending independent claims, when the insert sheet fed first, after a printing instruction has been given or a restart of sheet inserting operation, is not for the top page in a bundle of insert sheets, the insert sheets are discharged onto an escape tray until the insert sheet for the top page is detected. Independent claims 6 and 19 further call for discharging the insert sheets immediately preceding the same insert sheet page as a jammed insert sheet during the sheet inserting operation.

Inoue discloses inserting or interleaving a sheet of white paper between respective overhead head projector (OHP) sheets. The insert sheets are identical to each other, namely the same white sheets. See column 41, lines 61-65. As the insert sheets are identical, there would not have been any motivation for Inoue to assign or read identification information, let alone stacking the insert sheets in any predetermined order.

The examiner applied York for the proposition that it would have been obvious for Inoue to stack insert sheets in a predetermined order and to discharge insert sheets onto at least one tray other than the tray onto which the insert sheet to be inserted first is designated when the insert sheet fed is not the sheet to be inserted first. Referring to Figs. 2-3, York discloses dividing sheets 62 into groups of insertable items with one or more dividers 64, and directing the remaining insert sheets 62a into the overflow tray 72 when the insert sheets equal in number to the programmed number of copy sets are provided from an inserter 45. See column 6, lines 16-17 and 53-57, and column 9, lines 2-4. Like Inoue, however, York's insert sheets of each group (insertion stack 62a, 62b, 62c, 62d or . . . 62n) are identical. As the insert sheets are identical in York, there still would not have been any motivation for Inoue as combined with York to assign or read identification information, or stack the identical insert sheets in any predetermined order.

The examiner further argues that York teaches stacking bundles of insert sheets having different attributes, relying on the passage set forth in column 6, lines 22-30. Applicants submit that the passage relied upon by the examiner does not support the examiner's allegation of York explicitly teaching bundling insert sheets having different attributes. That is, the examiner's conclusion derived from this passage is that the bundles having different attributes can be stacked on a single supply tray. This passage does not support the examiner's conclusion simply because York does not care whether how many pages there are in a stack as long as there is a sufficient number to cover the copy set to be produced:

The operator is not required to count the number of insert sheets in each group but only to be assured that there are more sheets than the number of copy sets to be produced. [York, column 6, lines 32-35].

Indeed, this passage rather supports applicants' argument that the insert sheets are all the same. The number of pages need not be counted because they are all identical within the same stack. Accordingly, the combination urged by the examiner would not have taught the claimed invention.